



Paper No. 8

NIXON & VANDERHYE P.C.
8th Floor
1100 North Glebe Road
Arlington, VA 22201-4714

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JUL 03 2002

In re Application of
Laskey, et al.
Application No. 09/922,652
Filed: August 7, 2001
Title: Detection of Dysplastic or
Neoplastic Cells Using Anti-MCM2
Antibodies

OFFICE OF PETITIONS

DECISION ON PETITION

This is a decision on the petition, filed March 25, 2002, to accord the above-identified application a filing date of August 7, 2001, with pages 58, 59, 61, 67 and 68 of the specification as part of the original application disclosure. This petition is properly treated under §1.53(e) (2)¹.

Application papers in the above-identified application were filed on August 7, 2001. However, on March 1, 2002, the Initial Patent Examination Division mailed applicants a "Notice of Omitted Items in a Nonprovisional Application." Applicant was notified that the application papers had been accorded a filing date; however, pages 58, 59, 61, 67 and 68 of the specification appeared to have been omitted from the application. This Notice corrected the previously sent and withdrawn Notice mailed October 26, 2001.

In response, applicant timely filed the instant petition. Petitioner asserts that the allegedly omitted pages were in fact deposited in the USPTO with the non-provisional application papers on August 7, 2001; and accordingly, requests refund of the petition fee. In support thereof, petitioner submits a copy of their return postcard receipt. Petitioner further argues that the application as filed on August 7, 2001 was amended to incorporate by reference the text of the parent application Serial No. 09/175,947 (now U.S. Patent No. 6,303,323), which includes the subject matter of the allegedly omitted pages 58, 59, 61, 67 and 68. Petitioner submitted on petition replacement pages 58, 59, 61, 67 and 68.

A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of

¹ §1.53(e) Failure to meet filing date requirements.

... (2) Any request for review of ... a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in §1.17(h). In the absence of a timely (§1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e) (1) of this section will be the date the filing error is corrected.

receipt in the Office of all items listed thereon on the date stamped thereon by the Office. See MPEP 503. A review of petitioner's postcard receipt reveals that: 1) it was date stamped as received in the Office of Initial Patent Examination (OIPE) on August 7, 2001; 2) it specifically identifies the items being filed, including "88 Pages Specification" and 3) it lacks any annotation of nonreceipt of any item denoted on the postcard. Thus, petitioner has shown that the items denoted, including the 88 pages of specification, were filed on August 7, 2001.

The application papers already considered received in the Office on August 7, 2001, were reviewed along with the missing pages of specification submitted on petition. These papers together constitute the items described on the postcard receipt as 88 Pages Specification. Petitioner has shown that pp. 58, 59, 61, 67 and 68 of the specification were among the items present in the application on the date of deposit and should be included in the original application papers.

Moreover, a review of the application as filed reveals that it contains a transmittal sheet with a proper incorporation by reference statement,² as alleged.

Accordingly, the petition is GRANTED.

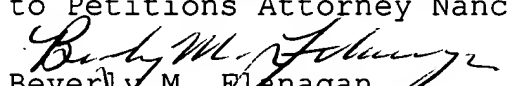
Given the basis for granting the petition, the petition fee has been refunded to Deposit Account No. 14-1140, as authorized.

The application is being forwarded to the Office of Initial Patent Examination (OIPE) for:

- further processing with a filing date of August 7, 2001, using the application papers received in the Office on that date and the missing pages of specification, pp. 58, 59, 61, 67 and 68, resupplied on petition filed March 25, 2002.

Applicant will receive appropriate notifications regarding the fees owed, if any, and other information in due course from OIPE.

Telephone inquiries specific to this decision should be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.


Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

² A proper incorporation by reference statement can be relied upon to permit the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference. See MPEP 201.06(c).